

11/15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : ESCH, Uwe et al.
Title : Hydraulic Circuit for a Hydraulic Excavator
Serial No. : 09/331,705
PCT No. : PCT/EP97/05792
Int. Filing Date : October 21, 1997
Priority Date : December 19, 1996

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 pursuant to 37 CFR 1.10 on the date shown below as
Express Mail Receipt No. EV 332246167 US
Name: Rajashree Mohabeer
Signature: Rajashree Mohabeer
Date: June 29, 2004

June 29, 2004

Mail Stop: PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
02-JUL-2004
Loyal S. Islam
International Division

Petition to Revive Unintentionally Abandoned Application Under 37 CFR § 1.137(b)

To the Commissioner for Patents:

A Notice of Abandonment dated February 18, 2000 was issued for the above-referenced patent application. The Notice of Abandonment indicated that the application was abandoned for failure to respond to the Notification of Missing Requirements issued on July 28, 1999. On November 9, 2000, the applicant's former attorney, Shahan Islam (Reg. No. 32,507) filed a petition to withdraw the holding of abandonment. A decision on the petition was issued on February 21, 2001. The petition filed on November 9, 2000 was considered deficient and the petition was denied. Applicant hereby files petitions the Commissioner to revive this application on the ground that the abandonment of the application was unintentional.

Mr. Islam left his employment at the applicant's attorneys' firm. Recently, applicant wrote to its attorneys to inquire of the current status of this application. Upon examination of its files, applicant's attorneys learned that this application had gone abandoned and although Mr. Islam filed a petition to withdraw the holding of abandonment of this application, the petition was denied. Applicant's attorney's file did not include a copy of the decision on the petition. The applicant's current attorneys contacted the PCT branch of the USPTO and obtained a copy of the decision on the petition filed November 9, 2000. The decision was faxed to applicant's current attorneys on June 17, 2004.

Applicant hereby submits that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

As required by 37 C.F.R. § 1.137(b)(1), enclosed herewith is a response to the Notification of Missing Requirements and Notification of a Defective Oath or Declaration dated July 28, 1999.

The Commissioner is hereby authorized to charge the fee required by 37 C.F.R. § 1.137(b)(2) and as set forth in 37 C.F.R. § 1.17(m) to Deposit Account No. 50-1290. It is believed that no other fees are due with this petition. However, if any other fees are due with this paper or the enclosed Response to Notification of Missing Requirements, the Commissioner is hereby authorized to charge such fee(s) to Deposit Account No. 50-1290.

Also enclosed are copies of the request for Change of Correspondence Information and the Sub-Power of Attorney faxed to Mr. Harry Kim of the USTPO on June 7, 2004.

Please direct any inquiries regarding this petition to the Applicant's undersigned attorney,
who may be reached directly by telephone at (212)940-8712.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Linda S. Chan', written over a horizontal line.

Linda S. Chan
Reg. No. 42,400

Attorney Docket No.: **2698/MEINKE/PCT (053735-00056)**
Customer Number: **026304**
Phone: (212)940-8800
Fax: (212)940-8776

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : **ESCH, Uwe et al.**
Title : **Hydraulic Circuit for a Hydraulic Excavator**
Serial No. : **09/331,705**
PCT No. : **PCT/EP97/05792**
Int. Filing Date : **October 21, 1997**
Priority Date : **December 19, 1996**

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Express Mail Receipt No. EV 332246167 US

Name: Rajashree Mohabeer

Signature: Rajashree Mohabeer

Date: June 29, 2004

June 29, 2004

Mail Stop: PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Notification of Missing Requirements Under 35 U.S.C. 371

To the Commissioner for Patents:

This is in response to the Notification of Missing Requirements mailed on July 28, 1999 and filed in connection with a Petition to Revive Under 37 CFR § 1.137(b) being filed concurrently herewith.

Applicant received a Notification of Missing Requirements with a Notification of a Defective Oath or Declaration dated July 28, 1999 (hereinafter "Notices"), a copies of which are enclosed herewith. The Notices indicated that the declaration of the inventors filed with the application was did not comply with 37 CFR 1.497(a) because the declaration did not identify the citizenship of each of the inventors.

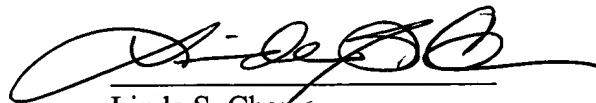
It is the applicant's belief that the Notices were issued in error as the declaration filed with the application noted the citizenship of each of the inventors as being from Germany. The citizenship of each inventor is noted in the section entitled "Staatsangehörigkeit" (German for "Nationality" or "Citizenship") on the declaration. Applicant is enclosing a copy of the originally filed German Language Declaration with the citizenship circled for reference.

In view of the foregoing, it is respectfully requested that this application now be allowed to continue to examination. As the Notices appear to have been issued in error, it is believed that no fee is due with this response. However, if any fee is due with this response, any such fee may be charged on Deposit Account No. 50-1290.

It is noted that a request for Change of Correspondence Information and a Sub-Power of Attorney were faxed to the USPTO on June 7, 2004 and copies of the same are being filed concurrently with this response and the petition to revive the current application.

Please direct any inquiries regarding this application to the applicant's undersigned attorney, who may be reached directly by telephone at (212)940-8712.

Respectfully submitted,



Linda S. Chan
Reg. No. 42,400

Attorney Docket No.: **2698/MEINKE/PCT (053735-00056)**
Customer Number: **026304**
Phone: (212)940-8800
Fax: (212)940-8776



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

9/331705

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/331,705	ESCH	U 2698/MEINKE/

SHAHAN ISLAM
FRIEDMAN SIEGELBAUM
7 BECKER FARM ROAD
ROSELAND NJ 07068

5071

INTERNATIONAL APPLICATION NO.

PCT/EP97/05792

I.A. FILING DATE	PRIORITY DATE
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10/21/97 12/19/96
07/28/99

DATE MAILED:

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1. ☐ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the specification to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☒ does not identify the citizenship of each inventor.
5. ☐ does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or city and foreign country of residence or each inventor.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).

Telephone: (703)



Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Box PCT
Washington, D.C. 20231

9/331705

U.S. APPLICATION NO.

FIRST NAMED APPLICANT

ATTY. DOCKET NO.

09/331,705

INTERNATIONAL APPLICATION NO.

3698/MEINKE/

SHAHAN ISLAM
FRIEDMAN SIEGELBAUM
7 BECKER FARM ROAD
ROSELAND NJ 07068

209 5071

PCT/EP97/05792

I.A. FILING DATE

PRIORITY DATE

DATE MAILED: 10/21/97

12/19/96

28 JUL 1999

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as

☒ a Designated Office (37 CFR 1.494),
☒ an Elected Office (37 CFR 1.495):

☒ U.S. Basic National Fee.

☒ Copy of the international application in:

☒ a non-English language.

☐ English.

☒ Translation of the international application into English.

☒ Oath or Declaration of inventor(s) for DO/EO/US.

☐ Copy of Article 19 amendments.

☐ Translation of Article 19 amendments into English.

☒ The International Preliminary Examination Report in English and its Annexes, if any.

☐ Translation of Annexes to the International Preliminary Examination Report into English.

☒ Preliminary amendment(s) filed 18 June 99 and _____

☒ Information Disclosure Statement(s) filed 18 June 99 and _____

☒ Assignment document.

☐ Power of Attorney and/or Change of Address.

☐ Substitute specification filed _____

☒ Statement Claiming Small Entity Status.

☐ Priority Document.

☒ Copy of the International Search Report ☒ and copies of the references cited therein.

☐ Other:

2. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

☐ a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.

☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.

☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).

☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.

☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.

☒ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☒ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.

5. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice *MUST* be returned with this response.

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875

FORM PCT/DO/EO/905 (December 1997)

Telephone: (703) _____

German Language Declaration

VERTRETUNGSVOLLMACHT: Als benannter Erfinder beauftrage rmit den nachstehend benannten Patentanwalt (ode die nachstehend benannten Patentanwälte) und/oder Patent-Agenten mit der Verfolgung der vorliegenden Patentanmeldung sowie mit der Abwicklung aller damit verbundenen Geschäfte vor dem Patent-und Warenzeichenamt:

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Stanley I. Rosen, Reg. No. 19,441
 Richard I. Samuel, Reg. No. 24,435
 Shahan Islam, Reg. No. 32,507
 Theresa A. O'Rourke, Reg. No. 40,747
 Nicholas J. DuBois, Reg. No. 41,719

Telefongespräche bitte richten an:
 Shahan Islam

Direct Telephone Calls to:
 (973) 992-1990, Ext. 191

Postanschrift:

Send Correspondence to:
FRIEDMAN SIEGELBAUM
 Seven Becker Farm Road
 Roseland, New Jersey 07068-1757

Unterschrift des Erfinders

Datum

Uwe Esch

14.6 Juni, 1999

Voller Name des einzigen oder ursprünglichen Erfinders:
 Uwe Esch

Wohnsitz

Harnackstrasse 8

D-44139 Dortmund

Germany

Staatsangehörigkeit

Germany

Postanschrift

Inventor's Signature

Date

Full name of first or sole inventor

Residence

Citizenship

Post Office Address

Inventor's Signature

Date

Full name of second joint inventor, if any

Residence

Citizenship

Unterschrift des Erfinders

Datum

Gottfried Drieschner

14. Juni, 1999

Voller Name des zweiten Miterfinders
 Gottfried Drieschner

Wohnsitz

Kirchhörder Kopf 53

D-44229 Dortmund

Germany

Staatsangehörigkeit

Germany

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to
(703) 305-2919 at the U.S. Patent and Trademark Office on
June 7, 2004


Eric L. Maldonado

Attorney Docket No.: 2698/MEINKE(053735-87549)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Uwe ESCH, et al.
Serial No. : 09/331,705
Filed : June 18, 1999
Title : HYDRAULIC CIRCUIT FOR...
Examiner :
Art Unit :

June 7, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

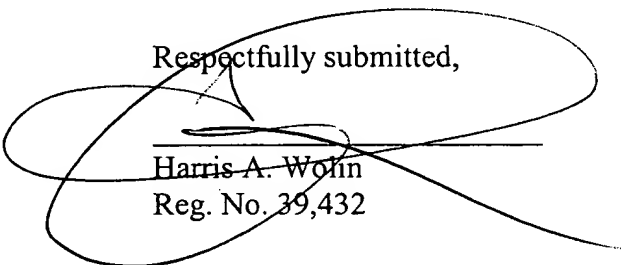
CHANGE OF CORRESPONDENCE INFORMATION

S I R :

Please address all future correspondence for the above referenced matter to the following:

**** Customer Number 026304 ****

Respectfully submitted,


Harris A. Wolin
Reg. No. 39,432

PHONE: (212) 940-8800; FAX: (212) 940-8776

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to
(703) 305-2919 at the U.S. Patent and Trademark Office on
June 7, 2004


Eric L. Maldonado

Attorney Docket No.: 2698/MEINKE(053735-87549)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Uwe ESCH, et al.
Serial No. : 09/331,705
Filed : June 18, 1999
Title : **HYDRAULIC CIRCUIT FOR...**
Examiner :
Art Unit :

June 7, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUB-POWER OF ATTORNEY

S I R:

I, Shahan Islam, attorney of record herein, do hereby grant a sub-power of attorney to Samson Helfgott, Reg. No. 23,072; Linda S. Chan, Reg. No. 42,400; Harris A. Wolin, Reg. No. 39,432, Brian S. Myers, Reg. No. 46,947; Thomas J. Bean, Reg. No. 44,528 and Michael I. Markowitz, Reg. No. 30,659 to act and sign in my behalf in the above-referenced application.

Respectfully submitted,



Shahan Islam
Reg. No. 32,507

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NEW YORK 10022-2585
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FAX: (212) 940-8776